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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,054	10/03/2000	Albrecht Dorschner	Beiersdorf 656-KGB	4744

7590

06/04/2003

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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

22

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N

09/679,054

Applicant(s)

DORSCHNER ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,7-13 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 5, 7-13 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/6/03 has been entered.
2. Claims pending are 5, 7-13 and 16-19. Claims 6, 14 and 15 have been cancelled. Claims 5, 7, 8, 10, 11, 16, 17 and 19 have been amended.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 7, 8 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 16-19 are viewed as indefinite because they depend from the cancelled Claim 1. Thus, the scope of the claimed invention is unascertainable because it is unclear what additional limitations are incorporated into Claims 7 and 16-19.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 7-13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Neumiller.

Thomas et al. teach oil-in-water microemulsions containing 0.1-20% of ethoxylated glycerol-based non-ionic surfactants, 0-5% of fatty acids such as stearic acid, anionic surfactants and 0.5-20% of insect repellents such as DEET. See Abstract; col. 4, lines 1-7; col. 5, lines 33-34. With respect to Claims 16 and 17, the claimed emulsifiers are well known in the emulsion art and are conventionally used for the same art-recognized purpose as the emulsifiers of Thomas et al. Thomas et al. do not teach glycerin of the instant claims. However, it is known to employ polyhydroxy alcohols such as glycerin in cleaning compositions for improving stability of the dispersed phase in the continuous phase. See Neumiller at col. 3, lines 34-40; col. 4, line 26; col. 5, lines 60-65. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use glycerin of Neumiller in cleaning compositions of Thomas et al. for its art-recognized purpose. One of ordinary skill in the art would be motivated to do this to obtain cleaning compositions with improved stability as suggested by Neumiller.

7. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Neumiller and further in view of Stewart.

Thomas et al. in view of Neumiller applied as above. Neither reference explicitly teaches ethyl 3-(N-acetyl-N-butylamino) propionate of the instant claims. However, Stewart

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teaches 3-[N-butyl-N-acetyl]-aminopropionic acid, ethyl ester can be used as an insect repellent "together with DEET, or instead of DEET". See col. 4, lines 50-59. This recently approved biochemical pesticide targets a variety of organisms such as pests, mosquitoes, deer ticks, body lice and biting flies. See col. 4, lines 50-57. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to employ ethyl 3-(N-acetyl-N-butylamino) propionate together with DEET or instead of DEET in the compositions of Thomas et al. as suggested by Stewart with a reasonable expectation of beneficial results such as obtaining a product having an increased range of pest/insect protection.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

8. Applicant's arguments filed 2/11/03 have been fully considered but they are not persuasive.

9. The Applicant's arguments over the Thomas et al. and Neumiller reference have been addressed previously. See Office Action mailed 11/15/02 (paper #16). Additionally, the Applicant argues that Claim 5 as amended "is not rendered obvious when the additional limitations with regard to the amount and specific type of emulsifier is (sic!) considered." In response, it is noted that Thomas et al. explicitly teach the amount and type of emulsifier as claimed in the amended Claim 5. More specifically, Thomas et al. teach 0.1-20% of ethoxylated glycerol-based non-ionic surfactants and 0-5% of fatty acids such as stearic acid.

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See above. The stearic acid of Thomas et al. will inherently act as emulsifier because it possesses emulsifying properties.

Conclusion

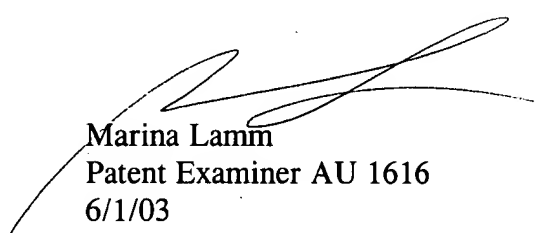
10. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Marina Lamm
Patent Examiner AU 1616
6/1/03